

Serial No. 10/633,772
Filed August 4, 2003
MS-02/3/US
Response to Office Action dated January 28, 2008

Cohen *et al.* (U.S. Patent No. 3,726,027, herein “Cohen”). This rejection is respectfully traversed.

1.1. Everett '222 is not prior art

Everett '222 issued on June 4, 2002, after the priority date of the present application, and is accordingly not available as prior art under 35 U.S.C. §102(a) or (b). Everett '222 was originally filed as a PCT application prior to November 29, 2000 and has a 35 U.S.C. §371(c)(1), (2) & (4) date of December 20, 2000, after the priority date of the present application, and is accordingly not available as prior art under 35 U.S.C. §102(e).

Applicant notes, however, that the Everett '222 specification published as International Patent Application Publication No. WO 99/56844 on November 11, 1999. For purposes of the present response, Applicant elects to consider this publication (herein “Everett '844”) in place of Everett '222 as the primary reference for all rejections in the present Action, but makes no admission as to its status as prior art under 35 U.S.C. §102(a) or otherwise.

1.2. Everett '844 in view of Cohen fails to render the instant claims obvious under the KSR v. Teleflex standard

The U.S. Supreme Court recently clarified the legal standard for a finding of obviousness in its decision in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), stating *inter alia* (emphasis added):

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Thus the question underlying an obviousness inquiry is not merely whether there was a reason or motivation to combine the cited documents, in this case Everett '844 and Cohen, but whether a reason existed at the time of the present invention to select from the individual cited documents the particular elements of the present invention and combine them in the

fashion claimed.

In the present Action, the Examiner begins the obviousness analysis by itemizing the two steps in Applicant's method. Applicant is unable to find either in Everett '844 or in Cohen the step of providing a kit of separate pieces to a dementia subject, or the step of encouraging the subject to arrange the pieces (deficiencies of the references that are explored more fully below), and further notes that it is the structural limitations of the kit, in combination with the two-step method, that define the present invention.

As an analogy, it would be unreasonable to suggest that treating a disease by the step of swallowing any known pill (e.g., one containing agent A known for a different use) is obvious just because it is known to treat the disease by the step of swallowing a pill containing unrelated agent B. In the same way, Applicant respectfully submits that it is unreasonable for the Examiner to take the position that “[i]n light of Everett's establishment that both steps of applicant's method are old and well known in the art, ... the substitution of alternative kits known in the art would have been obvious to one of ordinary skill in the art at the time of the invention whether or not those kits were designed for the purpose of therapy for dementia sufferers” (Action, page 3, lines 3–6, emphasis added). Setting aside for the moment the points (a) that Everett does not establish that both steps are old in the art, and (b) that Cohen fails to supply all claim elements missing from Everett '844 (points that are returned to below), Cohen's article has a different utility (teaching aid and educational toy) and no apparent reason exists for one of ordinary skill in the art to substitute Cohen's article for Everett's board game as a therapeutic device for subjects having dementia.

That said, the analysis must go further. In order to meet the *KSR v. Teleflex* standard for obviousness, an apparent reason must exist not only to substitute Cohen's article for Everett's board game, but to combine the particular elements from Cohen and Everett in the fashion claimed, i.e., in just the way these elements are combined (if indeed they are so combined) in Applicant's kit. No such reason is proposed in the present Action. In particular, no apparent reason exists for one of ordinary skill in the art to

- break Cohen's article apart to create a kit of separate pieces;

- adapt the separate pieces so created to be soft on all sides; or
- present the pieces for arrangement as opposed to providing them as projectiles to be cast into or on to targets on a moving board as in Everett '844.

It was the present inventors' observation and insight relating to the therapeutic benefit in dementia of tactile stimulation by different soft fabrics that led to the invention embodied in instant Claim 21. The co-action of the elements of Claim 21, in particular the dementia subject and the tactile differences of a variety of soft fabrics, ensures that Claim 21 is no mere assemblage of elements, each performing its known function. No prior art has been identified that would present a reason to combine the elements recited in Claim 21 in the fashion claimed therein; any assertion that it would be obvious to do so can only be made in hindsight. With respect to the characterization of Dondero (U.S. Patent No. 5,538,432) as evidence "that it is old and well known to provide [d]ementia subjects with pastimes involving the distinguishing of colors, shapes and textures" (Action, page 3, lines 14–15), Applicant respectfully reminds the Examiner that Dondero proposes rigid sensory elements, thus teaching away from the present invention, an essential feature of which is that tactile differences are provided by a variety of soft fabrics and/or subsurface layers that can be felt through a lightweight surface fabric.

In this regard, Applicant also submits that the teaching of Everett '844 is contrary to the particular combination of elements found in Claim 21. An essential feature of Everett's board game is the casting of projectiles. Applicant does not dispute that such a game can provide amusement and therapeutic benefit to dementia subjects, but the present inventors were more motivated to develop a pastime, puzzle or game that could be safely entrusted to dementia subjects in an institutional setting with minimal supervision. A game involving projectiles would be inimical to that objective. See the present specification at page 6, lines 12–15:

In a preferred activity aid, the pieces are soft on all sides and have no sharp edges or corners ... Such an activity aid therefore poses minimal risk of injury to a patient using the activity aid or to other people in the vicinity.

In brief, the present invention as defined by Claim 21 takes advantage in a new and

useful way of the relatively unimpaired sense of touch of a dementia subject (see the present specification at page 2, lines 10–12), and of insight on the part of the inventors that a simple pastime, puzzle or game relying on distinguishability of soft fabrics by sense of touch would be therapeutic to such a subject. Without that insight, the ordinary skilled person could perhaps randomly substitute any one of thousands of known toys and teaching aids for Everett's board game, but would have no apparent reason (as required for a showing of obviousness under *KSR v. Teleflex*) to select the particular toy or teaching aid described by Cohen for substitution into the method of Everett '844. And even if such a reason could be established, the substitution of any part or whole of Cohen's toy for any part or whole of Everett's board game would not yield the present invention, as will now be demonstrated.

1.3. No combination of elements from Everett '844 and Cohen satisfies all limitations of the instant claims

The present Action mischaracterizes Cohen as relating to a kit for assembly. "Cohen discloses that this concept [pieces covered in soft fabrics of differing tactility] is old and well known in the art of assembly of kits ... and note that the pieces can be flannel or fur" (Action, page 3, lines 22–23). The Examiner is respectfully reminded that, as previously pointed out, Cohen's toy is not a kit of separate pieces that are capable of arrangement as required by Claim 21. Applicant reiterates (response of May 8, 2007, page 10, 4th paragraph, emphasis in original):

In Cohen, the article provided to the subject is either a fully assembled polyhedron or a flat-form pattern which the subject can use to construct the polyhedron. Contrary to the Examiner's assertion ... construction from flat-form does not involve arrangement of separate pieces. As Cohen's Fig. 1 clearly shows, the flat-form pattern already contains all the faces necessary to form the polyhedron, and these faces are already fastened together with adhesive tape. Thus the faces of the polyhedron presented to the subject are not "separate" as required by the present claims.

Cohen's description of various methods of construction of the subject polyhedron (col. 2, lines 12–49) should not be misread as operating instructions. A reading of Cohen as a whole makes clear that in use, the polyhedron is intact or at least in flat-form. The separate

pieces required by Claim 21 to be provided to the subject for arrangement are not found in Cohen.

To the extent that Everett '844 discloses separate pieces, these are "selectively positioned and optionally detachable" geometric shapes (page 5, lines 17–18) which act as targets for projectiles; and the projectiles themselves, for example hoops, bean bags or weighted balls (page 8, lines 24–27). Note that in use, Everett's geometric shapes (targets) are *in situ* ("selectively positioned") and, although "optionally detachable," are secured to a board; during play they are not separate pieces that can be "arranged" by a subject as required by instant Claim 21. Everett's projectiles are likewise not "arranged" but are cast at the targets.

Thus at least one element of Claim 21, separate pieces that are arranged (as opposed to thrown at a target) by the subject, is not found in Everett '844 in view of Cohen.

Returning now to the Examiner's assertion that "Everett further discloses wherein the provided game is a kit ... for assembly" (Action, page 3, line 1, referencing Everett '222, col. 5, lines 29–43), Applicant respectfully disagrees. The cited passage of Everett '222, which corresponds to Everett '844, page 11, lines 1–15, is seen not to describe a game that involves assembly of pieces from a kit. It is true that, when setting up one form of Everett's game, geometric shapes are apparently placed in "recessed accommodation means" that provide "secure support" for the shapes. However, this assembly or set-up stage is not part of the play of the game and is not analogous to "encouraging and/or assisting the subject to arrange separate pieces from the kit in a simple assembly or construction pastime, puzzle or game" as recited in instant Claim 21. The kit of separate pieces for arrangement that is missing from Everett '844 is, as pointed out above, not supplied by Cohen.

1.4. Conclusion: a *prima facie* case of obviousness has not been made

For any of the reasons set forth above, the present Action fails to make a *prima facie* case of obviousness of Claim 21 over Everett in view of Cohen.

Claims 26 and 32–38 each depend directly or ultimately from Claim 21 and embody all limitations of Claim 21, thus are non-obvious for at least the same reasons that Claim 21 is

non-obvious.

Withdrawal of the present rejection of Claims 21, 26 and 32–38 under 35 U.S.C. §103(a) is respectfully requested.

2. Rejection under 35 U.S.C. §103(a) over Everett in view of Cohen and in view of Ostrar

Claims 22–25 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Everett in view of Cohen and further in view of Ostrar (U.S. Patent No. 5,738,559). This rejection is respectfully traversed.

Each of Claims 22–25 depends directly or ultimately from Claim 21, which, as shown above, is not *prima facie* obvious over Everett in view of Cohen. By the same token, Claims 22–25 are non-obvious over Everett in view of Cohen. What, then, does Ostrar add?

Ostrar's glove-puppet kit admittedly has some features in common with some of Claims 22–25, including attaching means in an edge region of a soft fabric piece. However, the shortcomings of the Everett/Cohen combination as evidence for non-obviousness of the present invention, including those embodiments defined by Claims 22–25, are not rectified by adding Ostrar to the combination.

Ostrar's kit is merely another of the thousands of possible toys and teaching aids that could have been randomly substituted for Everett's board game in a therapeutic method for dementia subjects; to select elements of Ostrar's kit and Cohen's article for substitution into Everett's game or method would have required the insight that the present inventors disclosed for the first time in the instant specification. Without that insight (that a simple pastime, puzzle or game relying on distinguishability of soft fabrics by sense of touch would be therapeutic to a dementia sufferer), the ordinary skilled person would have no apparent reason (as required for a showing of obviousness under *KSR v. Teleflex*) to select and combine elements of Everett, Cohen and Ostrar in the fashion presently claimed.

The statement in the Action (page 4, lines 9–11) that “[i]t would have been obvious to include this [Ostrar's] kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting such kits to dementia subjects for therapy” is wrong, not only because of the lack of any reason to combine the elements in the

fashion claimed, but also because, as pointed out in section 1.3 above, Everett does not describe a kit for arrangement in the manner required by the present claims, including Claims 22–25.

Withdrawal of the present rejection of Claims 22–25 under 35 U.S.C. §103(a) is respectfully requested.

3. Rejection under 35 U.S.C. §103(a) over Everett in view of Cohen and in view of Lockhart

Claim 27 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Everett in view of Cohen and further in view of Lockhart & Cooney (U.S. Patent No. Des. 277,492, herein “Lockhart”). This rejection is respectfully traversed.

Claim 27 depends ultimately from Claim 21, which, as shown above, is not *prima facie* obvious over Everett in view of Cohen. By the same token, Claim 27 is non-obvious over Everett in view of Cohen. What, then, does Lockhart add?

Lockhart’s puzzle design appears, as stated by the Examiner, to have multiple pieces that, on completion of the puzzle, reside inside a single aperture. However, from Lockhart’s figures, it is clear that the pieces are not “individually of such sizes and shapes as to fit together to form the shape of the aperture,” as required by Claim 27. Among other features missing from any combination of Everett, Cohen and Lockhart are pieces that are “soft on all sides.”

Again, the shortcomings of the Everett/Cohen combination as evidence for non-obviousness of the present invention, including the embodiment defined by Claim 27, are not rectified by adding Lockhart to the combination.

Lockhart’s puzzle is merely another of the thousands of possible toys and teaching aids that could have been randomly substituted for Everett’s board game in a therapeutic method for dementia subjects; to select elements of Lockhart’s puzzle and Cohen’s article for substitution into Everett’s game or method would have required the insight that the present inventors disclosed for the first time in the instant specification. Without that insight (that a simple pastime, puzzle or game relying on distinguishability of soft fabrics by sense of touch would be therapeutic to a dementia sufferer), the ordinary skilled person would have no

apparent reason (as required for a showing of obviousness under *KSR v. Teleflex*) to select and combine elements of Everett, Cohen and Lockhart in the fashion presently claimed.

The statement in the Action (page 4, lines 17–19) that “[i]t would have been obvious to include this kit [*i.e.*, Lockhart’s puzzle] in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting kits to dementia subjects for therapy” is wrong, not only because of the lack of any reason to combine the elements in the fashion claimed, but also because, as pointed out in section 1.3 above, Everett does not describe a kit for arrangement in the manner required by the present claims, including Claim 27.

Withdrawal of the present rejection of Claim 27 under 35 U.S.C. §103(a) is respectfully requested.

4. Rejection under 35 U.S.C. §103(a) over Everett in view of Cohen and in view of Studen

Claims 28 and 29 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Everett in view of Cohen and further in view of Studen (U.S. Patent No. 3,280,499). This rejection is respectfully traversed.

Claims 28 and 29 depend ultimately from Claim 21, which, as shown above, is not *prima facie* obvious over Everett in view of Cohen. By the same token, Claims 28 and 29 are non-obvious over Everett in view of Cohen. What, then, does Studen add?

That a game or puzzle involving fitting specifically shaped pieces to similarly shaped apertures (as described by Studen) is old in the art is not disputed. However, among features missing from any combination of Everett, Cohen and Lockhart are pieces that are “soft on all sides,” as required by Claim 21 and therefore by Claims 28 and 29.

Again, the shortcomings of the Everett/Cohen combination as evidence for non-obviousness of the present invention, including the embodiments defined by Claims 28 and 29, are not rectified by adding Studen to the combination.

Studen’s kit is merely another of the thousands of possible toys and teaching aids that could have been randomly substituted for Everett’s board game in a therapeutic method for dementia subjects; to select elements of Studen’s kit and Cohen’s article for substitution into

Everett's game or method would have required the insight that the present inventors disclosed for the first time in the instant specification. Without that insight (that a simple pastime, puzzle or game relying on distinguishability of soft fabrics by sense of touch would be therapeutic to a dementia sufferer), the ordinary skilled person would have no apparent reason (as required for a showing of obviousness under *KSR v. Teleflex*) to select and combine elements of Everett, Cohen and Studen in the fashion presently claimed.

The statement in the Action (page 5, lines 3–5) that “[i]t would have been obvious to include this [Studen's] kit in the therapeutic method of Everett because it would merely be using a known type of kit in a known method of presenting kits to dementia subjects for therapy” is wrong, not only because of the lack of any reason to combine the elements in the fashion claimed, but also because, as pointed out in section 1.3 above, Everett does not describe a kit for arrangement in the manner required by the present claims, including Claims 28 and 29.

Withdrawal of the present rejection of Claims 28 and 29 under 35 U.S.C. §103(a) is respectfully requested.

5. Rejection under 35 U.S.C. §103(a) over Everett in view of Cohen and in view of Kemnitzer and Ostrar

Claims 30 and 31 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Everett in view of Cohen and further in view of Kemnitzer (U.S. Patent No. 3,849,912) and Ostrar. This rejection is respectfully traversed.

Claims 30 and 31 depend ultimately from Claim 21, which, as shown above, is not *prima facie* obvious over Everett in view of Cohen. By the same token, Claims 30 and 31 are non-obvious over Everett in view of Cohen. What, then, does Kemnitzer (together with Ostrar) add?

Kemnitzer's toy admittedly has some features in common with Claims 30 and 31, including pegs (dowels) adapted to receive separate pieces. However, the shortcomings of the Everett/Cohen combination as evidence for non-obviousness of the present invention, including the embodiments defined by Claims 30 and 31, are not rectified by adding

Kemnitzer and Ostrar to the combination.

Kemnitzer's toy is merely another of the thousands of possible toys and teaching aids that could have been randomly substituted for Everett's board game in a therapeutic method for dementia subjects; to select elements of Kemnitzer's toy (somehow modified in view of Ostrar to provide fabric pieces) and Cohen's article for substitution into Everett's game or method would have required the insight that the present inventors disclosed for the first time in the instant specification. Without that insight (that a simple pastime, puzzle or game relying on distinguishability of soft fabrics by sense of touch would be therapeutic to a dementia sufferer), the ordinary skilled person would have no apparent reason (as required for a showing of obviousness under *KSR v. Teleflex*) to select and combine elements of Everett, Cohen, Kemnitzer and Ostrar in the fashion presently claimed.

The statement in the Action (page 5, lines 13–16) that “[i]t would have been obvious to include these kit features from Kemnitzer and Ostrar in the therapeutic method of Everett, because it would merely be using known kits and variations thereof in a known method of presenting kits to dementia subjects for therapy” is wrong, not only because of the lack of any reason to combine the elements in the fashion claimed, but also because, as pointed out in section 1.3 above, Everett does not describe a kit for arrangement in the manner required by the present claims, including Claims 30 and 31.

Withdrawal of the present rejection of Claims 30 and 31 under 35 U.S.C. §103(a) is respectfully requested.

6. Double patenting

It appears that the Examiner has overlooked the fact that a valid Terminal Disclaimer was filed in the present application on May 13, 2005, accompanied by the requisite fee. Although the selection of claims the Examiner has identified as subject to the double patenting rejection is slightly different from that previously identified, the prior patent (U.S. Patent No. 6,626,678) identified is the same. Applicant believes the existing Terminal Disclaimer is effective to overcome the present rejection. Withdrawal of the present rejection of Claims 21, 26–28, 30, 33–35 and 37–38 for double patenting is respectfully requested.

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Applicant appreciates the Examiner's concurrence that Applicant presently stands \$65 in credit with respect to this application, in view of double payment of a fee for filing a Terminal Disclaimer. Applicant will pursue the matter with an appropriate administrative branch of the Office.

7. Conclusion

Applicant believes the present submission to be fully responsive, all grounds of rejection being overcome or rendered moot. The application is believed to be in condition for allowance of all pending claims.

Respectfully submitted,



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